Attorney Docket No. PRIV-003/01US 307640-2004 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David S. ABDALLAH *et al.*		Examiner:	Techane Gergiso
Serial No.:	10/635,762	Art Unit:	2137
Filed:	August 6, 2003	Confirmation:	1715

For: **METHODS FOR SECURE ENROLLMENT AND BACKUP OF PERSONAL IDENTITY CREDENTIALS INTO ELECTRONIC DEVICES**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed August 20, 2008, the Advisory Action mailed December 2, 2008, and the Advisory Action mailed February 9, 2009, the deadline for responding to which is extended to February 20, 2009 with a three-month payment for Extension of Time, the Applicants respectfully request a review of the above-identified matter prior to filing an Appeal Brief. A Notice of Appeal is filed herewith under 37 C.F.R. § 41.31. No amendments are being filed with this request. The Applicants respectfully submit that a review is appropriate because the rejection under the first paragraph of 35 U.S.C. § 112 is improper due to the support for each claim by the specification. Additionally, the rejection under 35 U.S.C. § 103(a) is improper because the prior art fails to disclose or suggest each and every claim recitation.

The Applicant does not believe that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-1283.

ARGUMENTS

Introduction

Claims 15-21, 23-27, 34-36, 38-43 and 47-52 are currently pending in the application, with claims 15, 23 and 34 being the independent claims. Claim 23 stands rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. Claims 15-21, 23-27, 34-36, 38-43 and 47-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0115475 to Russo et al. ("*Russo*") in view of U.S. Patent No. 6,850,147 to Prokoski et al. ("*Prokoski*").

Independent claims 23 and 34 have support in the specification.

In the Advisory Action mailed February 9, 2009, the Examiner rejected independent claims 23 and 34 under the first paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement. The Applicants respectfully disagree for the following reasons.

The last sentence of paragraph [0081] of the specification recites, in its entirety, that "*at this point* all functionality within the personal identification device is disabled, *such that it is in a state waiting for future enrollment (step 107)*." Emphasis added. When paragraph [0081] refers to "at this point," it is referring to the point after pre-enrollment (e.g., the preceding portion of paragraph [0081]) and before the enrollment process (e.g., paragraphs [0082] and [0083]). The subsequent set of paragraphs of the specification, paragraphs [0082] and [0083], describe a process for enrolling personal identity credentials into the personal identification device. In other words, paragraphs [0082] and [0083] describe functionality of the personal identification device that is left enabled after the end of the pre-enrollment process referred to in paragraph [0081] (e.g., when the personal identification device is in a wait state for future enrollment). For example, the functionality of sending a digital certificate from the personal identification device to an enrollment party is disclosed in paragraph [0083]. Specifically, paragraph [0083] states that "the enrollment authority receives the personal identification device's digital certificate (steps 202 and 203)."

Independent claim 23 recites "sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment." The personal identification device is in a wait

state associated with future enrollment and has functionality associated with future enrollment enabled such as sending the digital certificate from the personal identification device to the enrollment party. Accordingly, the Applicants request that the rejection of independent claim 23 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

Note that the Advisory Action mailed February 9, 2009 rejects independent claim 34 under the first paragraph of 35 U.S.C. § 112, but independent claim 34 was not rejected under the first paragraph of 35 U.S.C. § 112 in the Final Office Action. Such a rejection new to an Advisory Action is improper. Without acquiescing to such a rejection, the rejection is traversed for the following reasons. Independent claim 34 recites "disabling functionality within the personal identification device except for functionality associated with future enrollment." As discussed above, the personal identification device has functionality associated with future enrollment enabled (e.g., the personal identification device is in a state waiting for future enrollment) when the other functionality is disabled after pre-enrollment. The recitation in claim 34 is nearly identical to the last sentence of paragraph [0081], and therefore is supported by the specification. Accordingly, the Applicants request that the rejection of independent claim 34 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

The claims are patentable over Russo in view of Prokoski because Russo in view of Prokoski fail to disclose or suggest all of the claim recitations.

Claims 15-21, 23-27, 34-36, 38-43 and 47-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Russo* in view of *Prokoski*. This rejection is traversed for the following reasons.

Generally speaking, during an enrollment process, a biometric of a user is enrolled in a device. Accordingly, the device can use the biometric of the user only after enrollment has been completed (i.e., during post-enrollment). Conversely, prior to enrollment (e.g., pre-enrollment, future enrollment or before enrollment), the device is initialized/configured for future enrollment and does not contain the biometric of the user. Thus, the device cannot use the biometric of the user until after the enrollment process is performed.

Russo, however, merely discloses sending a biometrically enhanced digital certificate to a device after enrollment. All of *Prokoski*'s disclosure identified by the Examiner (col. 5, lines 30-55; col. 6 lines 7-27; and col. 7, lines 3-23) is directed to post-enrollment events and not pre-enrollment events. For example, *Prokoski* discloses a personal biometric key that can

be used to unlock or access any device that has a biocompatible receiver during post-enrollment use. (See col. 6, lines 19-25).

Unlike independent claim 15, which recites "disabling functionality within the personal identification device except that the personal identification device is in a wait state associated with future enrollment," *Russo* in view of *Prokoski* is entirely silent. As the Examiner states in the Final Office Action, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, merely discloses post-enrollment use. Moreover, *Prokoski* fails to disclose or suggest any disabling of functionality within the personal identification device or a wait state associated with future enrollment. Accordingly, the Applicants request that the rejection of independent claim 15 and its dependent claims 16-21, 38-40 and 50 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 23, which recites "producing a digital certificate ... before enrollment of biometric data and sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment," *Russo* in view of *Prokoski* is entirely silent. As the Examiner states in the Final Office Action, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, is directed to post-enrollment use. Moreover, *Prokoski* does not disclose or suggest a personal identification device that has its functionality disabled except that functionality to send the digital certificate to an enrollment party during future enrollment is not disabled. Accordingly, the Applicants request that the rejection of independent claim 23 and its dependent claims 24-27, 41-43 and 51 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 34, which recites "disabling functionality within the personal identification device except for functionality associated with future enrollment," *Russo* in view of *Prokoski* is entirely silent for at least the reasons discussed above with respect to independent claim 15. Accordingly, the Applicants request that the rejection of independent claim 34 and its dependent claims 35-36, 47-49 and 52 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

The Applicant respectfully submits that, for at least the reasons stated above, the outstanding rejections are improper and the pending claims are allowable. Applicants respectfully request such a finding for the reasons set forth herein. Applicants would like to make clear that the arguments presented herein are merely those that are most appropriate for pre-appeal brief review and are certainly not the only arguments related to patentability. Additional and more detailed arguments are expressly reserved for an Appeal Brief.

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